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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,285	09/25/2006	Christoph Briehn	WAS0807PUSA	6497
22045	7590	06/07/2010	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			PAK, HANNAH J	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			06/07/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/599,285	BRIEHN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hannah Pak	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 March 2010.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 11-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>01/20/2010</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

1. All rejections, except for those maintained below, are withdrawn in light of applicants' remarks filed on 03/01/2010.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (US 6,306,502).

The rejection is adequately set forth in Pages 2-3 of Office action mailed on 12/03/2009 and is incorporated here by reference.

### ***Response to Arguments***

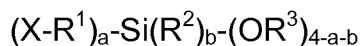
5. The applicants' arguments filed 03/01/2010 are fully considered but are not found persuasive for the following reasons below:

**(A)**

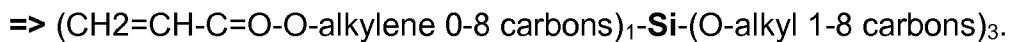
Applicants' Argument: The applicants argue that none of the specific and preferred alkoxy silanes listed in Fukushima are the claimed functionalized alpha-silanes (see Pages 6 and 8 of the Applicants' Remarks).

Examiner's Response: **1)** Like the applicants, Fukushima discloses a coating having improved abrasion (scratch)-resistant property containing the organosilane compounds (Col. 3, lines 10-32) encompassed by the claimed structural formula as shown below:

**Fukushima's organosilane**



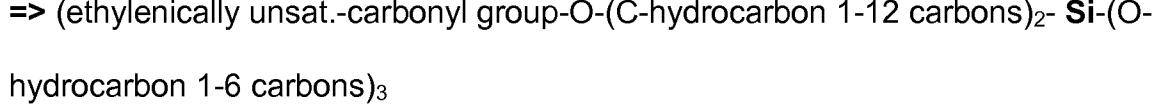
wherein X is  $CH_2-CH-COO$ ,  $R^1$  is an alkylene group having 0-8 carbons,  $R^3$  is an alkyl group having 1-8 carbons,  $a=1$  and  $b=0$ .



**The claimed structural formula for the organosilane in reverse order**



wherein C is an ethylenically unsaturated group, D is a carbonyl group, A is an oxygen group,  $R^3$  is a hydrocarbon having 1-12 carbons,  $R^2$  is a hydrocarbon having 1-12 carbons,  $R^1$  is a hydrocarbon group having 1-6 carbons, and n is 0.



**2)** Moreover, contrary to the applicants' argument, Fukushima is not limited to its examples, such as the specific and preferred alkoxy silanes.

**(B)**

Applicants' Argument: The applicants contend that the applicants satisfied the long felt need in the industry for scratch resistance coatings (see Pages 1 and 9 of the Applicants' Remarks). In support of this contention, the applicants rely on the Rule 132 declaration filed 03/01/2010 to provide proof that the claimed coating was widely accepted as satisfying the long felt need in the industry for scratch resistant coating (see Pages 2-3 of Rule 132 declaration filed 03/01/2010).

Examiner's Response: However, the declaration provides no objective evidence that the claimed scratch resistant coating satisfied the long felt need in the scratch resistant coating industry. Specifically, the applicants have not shown wide acceptance of the claimed coating in the industry for scratch resistant coating industry. Nor does the declaration show that such long felt need was not satisfied by Fukushima before the claimed invention since Fukushima also provides abrasion (or scratch) resistant coating which includes organosilanes encompassed by the claimed formula. See also MPEP § 716.02.

**(C)**

Applicants' Argument: The applicants contend that their claimed invention imparts unexpected results (see Pages 7 and 9 of the Applicants' Remarks). In support of this contention, the applicants rely on Rule 132 declaration filed 03/01/2010 to show

Examiner's Response: **1)** As recognized by the applicants in the declaration, the comparative example B (methacrylatopropyltrimethoxysilane of Fukushima) is encompassed by the broadly recited formula since the claimed hydrocarbon group containing 1-6 carbon atoms ( $R^1$  group) can include the propyl group as shown by the

comparative example B. When the prior art fully describes the claimed invention, a showing of unexpected results cannot be the basis for patentability. **2)** While the comparative example B provided in the prior art is said to show 24% loss of gloss, the applicants' own invention show loss of gloss up to 25 +/- 5 % in Table 1 of page 17 of the present specification. Thus, the applicants have not shown that the claimed invention imparts unexpected results. **3)** The applicants have not shown why the limited showing in the examples from the declaration and pages 13-15 of the present specification is commensurate in scope with the degree of protection sought by the very broad claims of the instant application. For instance, while the examples are directed to a showing of only one type of organosilane, e.g., methacrylatomethyltrimethoxysilane, the claims are not so limited. The claim broadly cited formula for the organosilane compound includes numerous organosilane compounds.

Accordingly, the applicants fail to rebut the *prima facie* case of obviousness established in the record.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571) 270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hannah Pak

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Art Unit: 1796

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Examiner  
Art Unit 1796

/HP/

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796